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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|-------------------------|---------------------|------------------|
| 10/697,058                | 10/30/2003  | Patrick Ward            | 40526-00035USPT     | 8125             |
| 7590                      |             | 12/15/2005              | EXAMINER            |                  |
| Alan R. Thiele            |             | CHOI, JACOB Y           |                     |                  |
| Strasburger and Price LLP |             | ART UNIT                |                     |                  |
| Suite 4400                |             | 2875                    |                     |                  |
| 901 Main Street           |             | DATE MAILED: 12/15/2005 |                     |                  |
| Dallas, TX 75202          |             |                         |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/697,058

Applicant(s)

WARD, PATRICK

Examiner

Jacob Y. Choi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claim 18 is objected to because of the following informalities: spelling error appears in line 5, where "a individual light source" should be corrected to "an individual light source". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-7, and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Rippel et al. (USPN 6,632,006).

Regarding claim 1, Rippel et al. discloses a light source (52) including an internal reflector (e.g., 52, 54) for emitting light, a mounting for the light source (6), the mounting constructed and arranged to position the light source near the plane of a ceiling (20) or a floor adjoining the wall and to direct the light emitted from the light source at an acute angle (claims 6 and 17) to a plane perpendicular to the plane of the ceiling (20) or the floor and away from the wall (e.g., Figure 6), an arcuate kick reflector (columns 4, lines

25-55) constructed and arranged to reflect the light emitted from the light source and direct the light emitted from the light source toward the wall (e.g., column 4, lines 25-40; *"the lamp 52 is positioned off the vertical axis of the finishing section 40 ... a kick reflector 45 to kick a portion of the light emitted outward from the fixture at high angles to illuminate a nearby wall close to the ceiling line"* & column 5, lines 15-25; *"the finishing section 40 and the aperture cone 60 may be rotated in collar 80 once they are installed in rough-in section 12 in order to aim or adjust the light output from the fixture 10 toward an nearby wall"*), whereby the combination of the mounting of the light source and the reflection of the arcuate kick reflector provides substantially uniform illumination of the wall (column 3, lines 1-10).

Note: claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 644 (CCPA 1974).

Regarding claim 3 and 9, Rippel et al. discloses the kick reflector (columns 4, lines 25-55) includes a reflective surface constructed and arranged to diffuse the light emitted by the light source and reflect the emitted light through the arcuate opening.

Regarding claim 4 and 10, Rippel et al. discloses a light-diffusing lens (66) between the light source and the kick reflector.

Regarding claim 5, Rippel et al. discloses a trim ring assembly connected to the adjustable mounting (column 5, lines 15-25).

Regarding claim 6, Rippel et al. discloses a housing (40) connected to the trim ring (41) assembly.

Regarding claim 7, Rippel et al. discloses a trim ring assembly, a housing (40) connected to the trim ring (41, 42) assembly, the housing constructed and arranged to provide a mounting for a light source (52) including an internal reflector (e.g., 53, 54), a light source positioning ring connected to the trim ring assembly and positioned within the housing, the light source positioning ring including a mounting surface positioned in a plane which is at an acute angle (claims 6 and 17) with respect to the plane of the trim ring assembly to direct the light emitted from the light source away from the wall (e.g., Figure 6), a substantially arcuate kick reflector having an arcuate opening, the substantially arcuate kick reflector constructed and arranged to be positioned within the light source positioning ring to reflect the light rays emitted from the light source toward the wall (e.g., column 4, lines 25-40; *"the lamp 52 is positioned off the vertical axis of the finishing section 40 ... a kick reflector 45 to kick a portion of the light emitted outward from the fixture at high angles to illuminate a nearby wall close to the ceiling line"* & column 5, lines 15-25; *"the finishing section 40 and the aperture cone 60 may be rotated in collar 80 once they are installed in rough-in section 12 in order to aim or adjust the light output from the fixture 10 toward an nearby wall"*), whereby substantially uniform illumination of an area on a wall is provided (column 3, lines 1-10).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 8, and 11-13, 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rippel et al. (USPN 6,632,006).

Regarding claim 2 and 8, Rippel et al. discloses a kick reflector 45 to kick a portion of the light emitted outward from the fixture at an angle to illuminate a nearby wall close to the ceiling

Rippel et al. failed to disclose the specifics of the acute angle is about 1 degree to about 5 degrees.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify workable ranges of the acute angle to illuminate the nearby wall from the ceiling, where the distance of the light from the wall would most likely determine the correct acute angle for the uniform illumination of the wall, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 11-13, 15-17, Rippel et al. discloses the structural limitations of the applicant's claimed invention, explained above.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify or claim of a use of a light fixture where Rippel et al. clearly provides the claimed structure that would perform the same.

It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

Regarding claims 18-20, Rippel et al. discloses a light source (6), a light fixtures, an individual light source including an internal reflector (e.g., 52, 54) for emitting light, an adjustable mounting for positioning the individual light source at an acute angle (claims 6 and 17) with respect to a plane perpendicular to either the ceiling (20) or the floor adjoining the wall to direct the light from the light source away from the wall (e.g., Figure 6), a housing for positioning the adjustable mounting, a trim ring assembly connected to the housing, a substantially arcuate kick reflector (columns 4, lines 25-55) having an arcuate opening, the substantially arcuate kick reflector constructed and arranged for directing light emitted from the light source in the wall, whereby the combination of the positioning of the light source and the substantially arcuate kick reflector (columns 4, lines 25-55) within the plurality of individual mounted light fixtures provides a substantially uniform level of illumination on the wall (e.g., column 4, lines 25-40; "*the lamp 52 is positioned off the vertical axis of the finishing section 40 ... a kick reflector 45 to kick a portion of the light emitted outward from the fixture at high angles to illuminate a nearby wall close to the ceiling line*" & column 5, lines 15-25; "*the finishing section 40 and the aperture cone 60 may be rotated in collar 80 once they are installed in rough-in section 12 in order to aim or adjust the light output from the fixture 10 toward an nearby wall*") ... a substantially arcuate kick reflector (columns 4, lines 25-55) having an arcuate

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opening therein, the substantially arcuate kick reflector positioned within the housing to reflect light from the light source toward a wall, the substantially arcuate kick reflector (columns 4, lines 25-55) including a curved planar interior reflecting surface ... the substantially arcuate shape of the kick reflector (columns 4, lines 25-55) is selected from a group including, substantially circular, substantially elliptical, and substantially oval.

Rippel et al. discloses the claimed invention except the prior art does not clearly show a plurality of individual light fixtures.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the plurality of light fixtures of Rippel et al. to the ceiling for even greater illumination through out the room or the wall, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Response to Amendment***

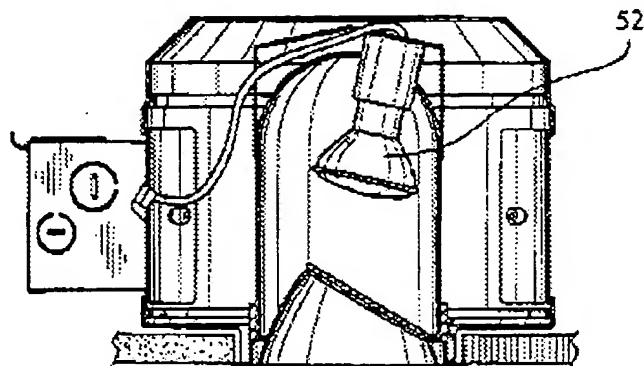
6. Examiner acknowledges that the applicant has amended claims 1, 3, 7, 11, 12, 16 & 19 and canceled claim 14.

### ***Response to Arguments***

7. Applicant's arguments filed 27 September 2005 have been fully considered but they are not persuasive.



In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"the light emitted from the light source at an acute angle to a plane perpendicular to the plane of the ceiling or of the floor and away from the wall (shown in Figure 6 in the prior art reference) ... an arcuate kick reflector constructed and arranged to reflect the light emitted from the light source and direct the light emitted from the light source toward the wall"* (disclosed in column 4, lines 25-40; *"the lamp 52 is positioned off the vertical axis of the finishing section 40 ... a kick reflector 45 to kick a portion of the light emitted outward from the fixture at high angles to illuminate a nearby wall close to the ceiling line"* & column 5, lines 15-25; *"the finishing section 40 and the aperture cone 60 may be rotated in collar 80 once they are installed in rough-in section 12 in order to aim or adjust the light output from the fixture 10 toward an nearby wall"*)) are clearly thought by cited prior art, Rippel et al. (USPN 6,632,006).



### Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC



**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**